

REMARKS

Any fees that may be due in connection with filing this paper or with this application during its entire pendency may be charged to Deposit Account No. 02-1818. If a petition for extension of time is required, this paper is to be considered such Petition, and any fee charged to Deposit Account No. 02-1818.

Amendment of the Claims

Claims 1, 10-13, 20, 34-36, 40-46, 48-55, 108-109, 113-116, 118-120, and 122-126 are allowed. Claim 1 is amended to correct a grammatical error (a misplaced modifier) introduced by the Examiner's amendment. The amendment renders it clear that it is the free Cys, not the protease domain that is disulfide bonded to Cys in the pro-domain. No new matter is added. Accordingly, entry of this amendment respectfully is requested.

Supplemental Information Disclosure Statement

Provided herein is a copy of a *Supplemental Information Disclosure Statement* that was mailed December 26, 2007. Receipt of this *Supplemental Information Disclosure Statement* was acknowledged by the Office as evidenced by the date stamp on the first page, indicating the date of December 26, 2007. The *Supplemental Information Disclosure Statement* included a copy of an Examination Report that issued in a related case, and a Table with a box for the Examiner to initial that the Examiner considered the Examination Report. This *Supplemental Information Disclosure Statement* was mis-coded in the system as a Transmittal Letter.

Applicant's representative contacted Examiner Pak prior to the issuance of the *Notice of Allowance*, who indicated that she would initial the table evidencing consideration of the Examination Report from the related case. Subsequently, the *Notice of Allowance* was mailed and Examiner Pak did not initial the table, nor did she indicate that there was a problem with the *Supplemental Information Disclosure Statement* as filed. Applicant's representative contacted Examiner Pak after the issuance of the *Notice of Allowance* and at this time Examiner Pak indicated the *Supplemental Information Disclosure Statement* was a "transmittal letter" and could not be considered because page 2 of the *Supplemental Information Disclosure Statement* did not have a header that stated it was an Information Disclosure Statement.

Applicant respectfully disagrees. The *Supplemental Information Disclosure Statement*, mailed on December 26, 2007, contains the following information:

- a) the application number of the application in which the Information Disclosure Statement is being submitted;

- b) a column that provides a space, next to each document to be considered, for the Examiner's initials;
- c) a heading on page 1 that states "Supplemental Information Disclosure Statement";
- d) a header on the page 2, that contains the Table, that indicates it is "Page 2 of 2"; and
- e) the paragraph on page 2 below the Table states "... the filing of this Information Disclosure Statement...".

Therefore the Applicant asserts the *Supplemental Information Disclosure Statement* is not a "transmittal letter", that it is clear that it should not be misconstrued as such, and Applicant respectfully requests that Examiner consider and initial all information listed in the Table submitted in the *Supplemental Information Disclosure Statement* filed December 26, 2007. For the convenience of the Examiner, a copy of the *Supplemental Information Disclosure Statement* is attached hereto.

Comments on Examiner's Statement of Reasons for Allowance

Applicant recognizes that in accord with M.P.E.P. §1302.14, the Examiner's reasons for allowance, as set forth in the *Notice of Allowance*, dated August 6, 2009, need not set forth all of the details as to why the claims are allowed. In the above-referenced application, Applicant does not concede that the Examiner's stated reasons for allowance are the only reasons for which the claims are allowable. The claims may be patentable for additional reasons. In addition, Applicant has the following comments.

In setting for reasons for allowance, the Examiner notes that the arguments in the Appeal Brief, filed April 22, 2009, "in conjunction with the Examiner's Amendment overcome the rejections previously applied."

Applicant respectfully disagrees. Prior to the Examiners amendment, claim 1 read:

An isolated, substantially purified single-chain poly-peptide, consisting only of a protease domain of a type-II membrane-type serine protease (MTSP) or a catalytically active fragment thereof as a single chain, wherein:

a free Cys in the protease domain is replaced with another amino acid; and
the MTSP protease domain or catalytically active fragment thereof has serine protease activity as a single chain.

In the Examiner's amendment, "catalytically active fragment" was replaced with "proteolytically active fragment." There was no rejection on the record objecting to recitation of "catalytically active fragment." Hence, arguments in the Appeal Brief did not address this issue. Applicant agreed to the amendment in a subsequent Examiner-initiated

Applicant : Madison *et al.*
Serial No. : 09/776,191
Filed : February 2, 2001

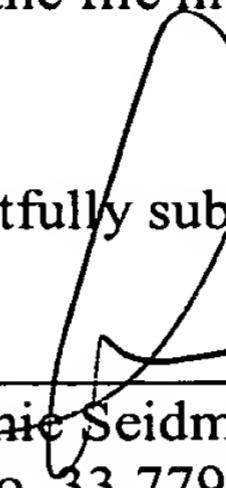
Attorney Docket No. 3800029.00028/1607
**Amendment Pursuant to 37 C.F.R. §1.312 and
Comments on Reasons for Allowance**

telephonic interview. It respectfully is submitted that the amended and previous recitations are synonyms and are so-defined in the application, and, thus, did not change the scope or content of the claims nor did they address any issue previously of record.

* * *

Entry of these remarks and the amendment into the file history of the above-captioned application respectfully is requested.

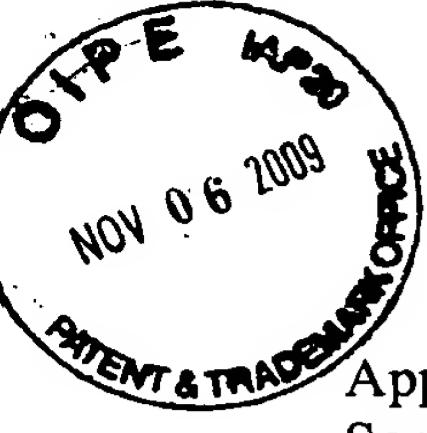
Respectfully submitted,


Stephanie Seidman
Reg. No. 33,779

Attorney Docket No. 3800029.00028 / 1607

Address all correspondence to: 77202

Stephanie Seidman
K&L Gates LLP
3580 Carmel Mountain Road, Suite 200
San Diego, CA 92130-6766
Telephone: (858) 509-7400
Facsimile: (858) 509-7466
email: stephanie.seidman@klgates.com



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Madison *et al.*

Serial No. : 09/776,191

Filed : February 2, 2001

Art Unit : 1652

Examiner : Yong D. Pak

Confirm. No.: 3237

Title : NUCLEIC ACID MOLECULES ENCODING TRANSMEMBRANE SERINE PROTEASES, THE ENCODED PROTEINS AND METHODS BASED THEREON

Mail Stop ISSUE FEE

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

ATTACHMENT

1. Copy of Supplemental Information Disclosure Statement, filed December 26, 2007, in U.S. Application Serial No. 09/776,191



Attachment 1: Copy of Supplemental Information Disclosure Statement, filed December 26, 2007, in U.S. Application Serial No. 09/776,191



**Attachment to Comments of Reasons
for Allowance: Copy of Supplemental
Information Disclosure Statement,
filed December 26, 2007** | Attorney's Docket No.: 17106-017001/1607

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Madison et al.
Serial No. : 09/776,191
Filed : February 2, 2001

Art Unit : 1652
Examiner : Yong D. Pak
Conf. No. : 3237
Cust. No. : 20985

Title : NUCLEIC ACID MOLECULES ENCODING TRANSMEMBRANE SERINE PROTEASES, THE ENCODED PROTEINS AND METHODS BASED THEREON

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT IN ACCORDANCE
WITH 37 C.F.R. §§ 1.97-1.98**

Because this Supplemental Information Disclosure Statement is filed after the receipt of a First Office Action on the Merits for the above-captioned application, a check for the filing fee of \$180.00 is enclosed. If no proper payment is enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1050.

In accordance with the duty of disclosure imposed by 37 C.F.R. §1.56 to inform the Patent Office of all information known by Applicant or Applicant's representative that may be material to the examination of the subject application, Applicant's representative hereby provides this Supplemental Information Disclosure Statement that is prepared in accordance with 37 C.F.R. §§1.97-1.98. Forms PTO-1449 (1 page). Copies of cited non U.S. Patent documents are provided herewith (1 bound volume). The documents cited on the Forms PTO-1449 are in the English language. Hence, in accordance with the requirements of 37 C.F.R. §1.98, as amended effective March 16, 1992, no further explanation of the listed items is necessary.

Provided herewith is a copy of a European Examination Report (Document I), issued April 24, 2007, in connection with corresponding European Patent Application No. 01905377.6 (Attorney Docket No. 17106-017EP1/1607EP). European Patent Application No. 01905377.6 is a national stage filing of International Patent Application No. PCT/US01/03471, which corresponds to the instant application filed in the United States on the same date and claims priority to U.S. provisional Application No. 60/179,982, to which the instant application also

CERTIFICATE OF MAILING BY "EXPRESS MAIL"
"Express Mail" Mailing Label Number EV 965985621 US
Date of Deposit December 26, 2007

I hereby certify that this paper is being deposited with the United States Postal "Express Mail Post Office to Addressee" Service under 37 CFR §1.10 on the date indicated above and is addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

Stephanie Seidman

12/28/2007 EHAILE! 08000073 09776191
01 FC:1806 180.00 OP

COPY

**Attachment to Comments of Reasons
for Allowance: Copy of Supplemental
Information Disclosure Statement,

Applicant : Madison et al. filed December 26, 2007**

Attorney's Docket No.: 17106-017001/1607

Serial No. : 09/776,191

Filed : February 2, 2001

Page : 2 of 2

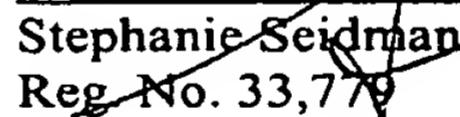
claims priority. In the Report, European Examiner cites one reference: D4 (La Vallie et al., *Journal of Biological Chemistry*, 268(31):23311-23327, (1993)). This reference is of record in the instant application, in the Information Disclosure Statement filed January 9, 2002, supplied with Form PTO-1449. The table below lists Document I and includes a column that provides a space next to the document to be considered, for the Examiner's initials.

Examiner Initial	Document No.	Document
	I	Copy of European Examination Report, issued April 24, 2007, in connection with corresponding European Patent Application No. 01905377.6

Although these documents are made known to the Patent and Trademark Office in compliance with Applicant's duty of disclosure, such disclosure is not to be construed as an admission by Applicant or Applicant's representative that any of the documents or information, singly or in any combination thereof, is effective as prior art against the subject application. In accordance with 37 C.F.R. §1.97(h), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 C.F.R. §1.56(b) exists.

Applicant respectfully requests that the Examiner review the foregoing document and that it be made of record in the file history of the above-captioned application.

Respectfully submitted,


Stephanie Seidman
Reg. No. 33,779

Attorney Docket No. 17106-017001/1607

Address all correspondence to:

Stephanie L. Seidman

Fish & Richardson P.C.

12390 El Camino Real

San Diego, California 92130

Telephone: (858) 678-4777

Facsimile: (202) 626-7796

email: seidman@fr.com